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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
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Washington, DC 20037

EXAMINER

POE, MICHAEL I

ART UNIT PAPER NUMBER

1732

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/727,591

Applicant(s)

FERRAILOLO, FRANCESCO

Examiner

Michael I Poe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 6-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Amendments*

1. Applicant's amendment A filed on December 4, 2000 has been entered. Based upon the entry of this amendment, existing claims 8 and 12 have been amended, no existing claims have been canceled, and new claim 13 has been added. Claims 1-13 are currently pending.

### *Election/Restrictions*

2. Applicant's election without traverse of the species of Group I illustrated in Figures 7 and 8, claims 1-5, in Paper No. 6 is acknowledged.

3. Claims 6-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species and inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

### *Specification*

4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.

(b) CROSS-REFERENCE TO RELATED APPLICATIONS.

(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.

(d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC

(See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)),

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"Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "mattress-like type" in claim 1 is a relative term which renders the claim indefinite. The term "mattress-like type" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of

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the scope of the invention. Specifically, it would be unclear to one reading the claim what type of protecting and immobilizing elements the applicant would consider mattress-like. For the purpose of this Office action, the examiner has assumed that the applicant was attempting to claim a protecting or immobilizing element in the form of a mattress.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application No. EP 0881334 A1 (Pavani) in view of U.S. Patent No. 4,477,206 (Papetti et al.).

**Claims 1 and 2**

Pavani teaches a method for manufacturing a flexible mat component for protecting, ballasting and supporting submarine pipelines and cables (a process for manufacture of a protecting and immobilising element of the mattress) including lining (arranging) the internal space of a component forming box (containing means; mould) with a case 2 (a layer of flexible material); positioning, inside the internal space thus lined, a plurality of lifting elements 7 (anchoring means) composed of a segment of rubber tube 8 having a piece of perpendicular tube 11 through holes in the tube 8; positioning a wire net 5 (first netting structure) on the lifting elements 7 such that the tube 11 supports the wire net 5 and the upper end of the tube 8 protrudes through the wire net 5 (the anchoring means passing through the netting structure at predetermined positions); introducing (filling) in the internal space a hot premixed filler material 6, 6a (a filling material) composed of a rock aggregate 6 (solid elements) whose dimensions are such that it passes through the meshes of the wire net 4 and an asphalt cement 6a (fluid elements) until a level equal to the final thickness of the component is reached; and covering (superimposing, at least partially) the filler material 6, 6a with the case 2 (the peripheral edges of the flexible layer) such that the

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lifting elements 7 protrude through the top of the case 2 (in such a manner as to produce a closed cover from which the ends of the anchoring means protrude) (title; abstract; column 2, line 32 - column 3, line 9; column 3, line 55 - column 4, line 18; Figures). Note that, in order for the case 2 to cover the filler material 6, 6a after the filler material 6, 6a is introduced, the peripheral edges of the case must inherently protrude from the component forming box.

Pavani does not specifically teach that the first netting structure is in direct contact with the flexible layer and superimposing a second netting structure on the filling material prior to superimposing the peripheral edges of the flexible layer. However, these limitations would have been obvious to one of ordinary skill in the art in view of Papetti et al. as further discussed hereafter. Papetti et al. teach a flexible mattress usable as a ballast for immobilizing and protecting underwater pipelines comprising an outer flexible envelope (a layer of flexible material) covering at least one gabion, made from double-twist, hexagonal-mesh wire netting in the form of a somewhat-flattened parallelepiped having an integral or separable lid (superimposing a second netting structure on the filler material), filled with a mixture of stones or pebbles with a sand-, filler- and bitumen-based mastic; a supporting member which is disposed within the gabion adjacent its respective bottom wall and in contact with the outer flexible envelope (a first netting structure being in direct contact with the flexible layer); and a plurality of coupling members, connected to anchoring means attached to the supporting member (the anchoring means passing through the netting structure at predetermined positions), that have a portion which projects from the upper surface outer flexible envelope (a closed cover from which the ends of the anchor means protrude) and is formed to allow their coupling to external lifting devices (title; abstract; column 2, lines 34-58; column 3, lines 37-59; column 4, line 66 - column 5, line 65; column 6, lines 16-21). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to use a supporting member in contact with the bottom surface of the case for positioning the lifting elements against the bottom surface of the case and to superimpose a lid material on the surface of the filler material prior to superimposing the case in the process of Pavani as taught by Papetti et al. to provide positional accuracy of the lifting elements by preventing movement

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of the lifting elements during filling with the filler material and to increase the strength and durability of the component by enhancing the reinforcement of the component.

***Allowable Subject Matter***

9. Claims 3-5 are would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

- (1) the prior art of record does not teach or suggest the claimed process for the manufacture of a protecting and immobilizing element in the form of a mattress, as a whole, especially including providing an anchoring means comprising at least one plate secured to a body of the anchoring means extending perpendicularly relative to the surface of the plate wherein the plate is sandwiched between a first netting structure and a layer of flexible material.

Note that, although not currently claimed, the species illustrated in Figure 10 would be allowable over the prior art of record for the reasons set forth above with regard to the species of Figure 8 (e.g., claims 3-5).

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 841,281 (Thorne), U.S. Patent No. 4,726,708 (Papetti), U.S. Patent No. 5,259,704 (Orgorchock), U.S. Patent No. 5,368,410 (Ferraiolo), Japanese Patent Publication No. 56-052209 A (Hiroshi et al.), German Patent Publication No. DE 3532640 A1 (Rooy), Great Britain Patent No. 2,178,127 A (Cotter), Japanese Patent Publication No. 03-224913 A (Tadashi), Japanese Patent Publication No. 06-146239 A (Kenichi) and Japanese Patent Publication No. 2003-232024 A (Rikako et al.) have been cited of interest to show the state of the art at the time the invention was made.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael I Poe whose telephone number is (571) 272-1207. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianne can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael Poe/mip



**MARK EASHOO, PH.D**  
**PRIMARY EXAMINER**

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29/Dec/03